

**Amendment**

U.S. Patent Application Serial No. 10/723,692

Office Action Dated: November 30, 2007 and

Office Communication Dated: January 29, 2008

Inventor: James B. McCormick

Attorney Docket No. 46521-56177

**REMARKS**

This Amendment is filed in response to the Office Action dated November 30, 2007 and Office Communication dated January 29, 2008. Applicant's attorney would like to deeply apologize for any misunderstanding. Applicant's attorney proposed a claim amendment in a voice mail and was instructed by the Examiner Ramillano to file this proposed claim amendment in writing. There was never an indication from the Examiner Ramillano that this claim amendment would allow the case but just a preference that a written submission would be desired by the Examiner rather than receiving a proposed claim amendment by means of telephonic communication.

Claims 8-10 are cancelled to comport with the *Manual for Patent Examining Procedure* (M.P.E. P.) § 821.01 since Claims 8-10 are directed a nonelected invention, without traverse, in accordance with the Examiner's outstanding suggestion.

**Rejection Under 35 U.S.C. § 102(b):**

Claim 1 was rejected under 35 U.S.C. § 102(b) as being unpatentable over Dyke (U.S. Patent No. 4,874,090). These claims are specifically amended to refer to a "liquid permeable sheet" and "liquid permeable target", wherein "the liquid is utilized in histological examination." Support for this amendment can be found on Column 2, Lines 52-58 of U.S. Patent No. 5,080,869 as follows: "Other objects of the invention include providing continuous flow systems and reciprocating flow systems for tissue

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processing **liquids** which recycle the various reagents that are used for processing tissue samples and in the economical use of processing cassette components in the final stage of tissue embedding and slicing." U.S. Patent No. 5,080,869 is incorporated by reference in this Patent Application, i.e., U.S. Patent Application Serial No. 10/723,692 in Paragraph [0002], Lines 4-6 (emphasis added). Therefore, no new matter has been added.

A liquid is defined as: "a substance, such as water, that is **not solid or a gas** and that can be poured easily." <http://dictionary.cambridge.org/define.asp?key=46477&dict=CALD> (emphasis added).

Dyke requires: "A sterilizable pouch comprising: a first sheet-like member made of a material which is **impermeable to microorganisms** and a second sheet-like member, opposing said first member, made of a material which is **impermeable to microorganisms**,..." (Claim 1, Column 4, Lines 5-9) (emphasis added). **It is respectfully believed that a surface that is impermeable to microorganisms would not be permeable to liquids.** It is respectfully believed that even under the broadest possible claim interpretation, the term "liquid" cannot include gases and ethylene oxide. Under 35 U.S.C. § 102, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). "A claim is anticipated only if each

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and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, when evaluating a claim for either anticipation or obviousness, all claim limitations must be considered. *In re Evanega*, 829 F.2d 1110, 4 U.S.P.Q. 2d 1249 (Fed. Cir. 1987).

Furthermore, proper application of a reference against a device described and claimed in a patent application requires broadly that the anticipatory device be substantially the same as the anticipated device in function, structure and result. In this case, a sheet and target that are both **liquid permeable** do not have the same function, structure and result as a sheet that is impermeable to microorganisms.

It is respectfully believed that there is now a structural difference between the claimed invention and the prior art that patentably distinguishes the claimed invention from the prior art.

Therefore, it is respectfully believed that Claim 1 overcomes the rejection under 35 U.S.C. § 102(b) and is patentable over Dyke and is in condition for allowance.

Claims 2, 5-7 depend from independent Claim 1, which are respectfully believed to overcome the 35 U.S.C. § 102(b) rejection over Dyke in the same manner as Claim 1 as described above. If an independent claim is not anticipated, then any claim

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depending therefrom is also not anticipated. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Claims 2, 5-7 are also amended to refer to both a liquid permeable sheet and a liquid permeable target.

Therefore, it is respectfully believed that Claims 2, 5-7 overcome the rejection under 35 U.S.C. § 102(b) and are patentable over Dyke and are in condition for allowance.

#### **Rejection Under 35 U.S.C. § 103(a):**

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dyke (U.S. Patent No. 4,874,090) in view of Rochette (U.S. Patent No. 3,537,636). Rochette refers to: "...a sheet of cellulose film." (Column 1, Lines 64-65). It is believed that this material is also known as cellophane. This material is **liquid impermeable**. It is respectfully believed to be axiomatic that the combination of two references that disclose liquid impermeability cannot create a liquid permeable sheet by combination of these two references.

*US v. duPont* 351 U.S. 377 (1956) recites: "Moistureproof cellophane is highly transparent, tears readily but has high bursting strength, is **highly impervious to moisture and gases**, and is resistant to grease and oils. Heat sealable, printable, and

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adapted to use on wrapping machines, it makes an excellent packaging material for both display and protection of commodities" (emphasis added).

Moreover, there is no teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007). In determining obviousness, the proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. "To reject a claim based on this rationale, U.S. Patent Office personnel must resolve the Graham factual inquiries. Office personnel must then articulate the following: (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference; (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately." (Federal Register / Volume 72, No. 195 / Wednesday, October 10, 2007 / Notices, Page 57529, "Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*"). In this case, both Dyke and

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Rochette function in a totally different manner with liquid impermeability rather than Applicant's claimed Invention specifically reciting liquid permeability. Therefore, the mere combination of Dyke and Rochette would absolutely not be sufficient for a valid rejection under 35 U.S.C. § 103(a). Consequently, it is respectfully believed that a proper rejection under 35 U.S.C. § 103(a), based on the United States Patent Office's own guidelines, cannot be made. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 U.S.P.Q.2d 1329, 1335 (Fed. Cir. 2006).

Claims 3 and 4 depend from independent Claim 1, which are respectfully believed to overcome the 35 U.S.C. § 103(a) rejection over Dyke in the same manner as Claim 1 as described above. If an independent claim is not anticipated or obvious, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Therefore, Claims 3 and 4 overcome the rejection under 35 U.S.C. § 103(a) and are in condition for allowance.

Therefore, it is now believed that all of the pending Claims in the present application are in condition for allowance. Favorable action and allowance of the Claims is therefore respectfully requested. If any issue regarding allowability of any of

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the pending Claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's Amendment, or if the Examiner should have any questions regarding the present Amendment, it is respectfully requested that the Examiner please telephone the Applicant's undersigned attorney in this regard.

Respectfully submitted,

**Thompson Coburn LLP**

By: 

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